

REMARKS

Claims 2-4 and 6-22 are currently pending in the instant application. Claims 19-22 are independent, claims 1 and 5 canceled in a previous response. Reconsideration is kindly requested.

Claim Amendments

Claims 19-22 have been amended merely for clarification purposes, the amendments herein are not related to reasons of patentability.

Allowable Subject Matter

Applicants acknowledge the Examiner's indication that claims 6-18 contain allowable subject matter.

Rejection Under 35 U.S.C. § 103

Claims 2-4 and 19-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Applicants' admitted prior art in view of Pinney (U.S. Patent No. 5,446,367). This rejection is respectfully traversed.

The Applicants' admitted prior art, hereinafter 'AAPA', illustrates a conventional apparatus for supplying DC bias current, as shown in FIG. 1. Applicants submit that FIG. 1 does not include all of the claimed features disclosed in claim 19. The Examiner already admits that the AAPA fails to teach the third electrical circuit recited in claim 19. However, the Examiner relies on the current limiter circuit 204 of Pinney to allege that Pinney teaches a "third electrical circuit connected to both the first and second circuits for limiting the value of the bias current to

a predetermined level in response to an abnormal current condition of the circuit element" as recited in claim 19, and as somewhat similarly recited in claims 20-22. Applicants disagree.

As indicated by the examiner, FIG 1. of the AAPA fails to disclose a third electrical circuit for limiting the current. Applicants submit that, in addition to the third electrical circuit not being present in the AAPA, the Examiner has failed to provide a reference that teaches or suggests other claimed features of claim 19.

In particular, neither AAPA nor Pinney teach or suggest limiting the value of the bias current to a predetermined level in response to an abnormal current condition of the circuit element. Applicants have reviewed the disclosure of Pinney in its entirety, and can find no teaching or suggestion of the above feature of claim 19. This is because Pinney limits bias current drawn by a pre-regulator 204 as soon as a power signal VCCR on line 56 initially reaches a stable condition (col. 7, lines 1-2). Power signal VCCR on line 56 is not a circuit element operating in response to a bias current fed thereto, as recited in claim 19 and as somewhat similarly recited in claims 20-22. Accordingly, for at least this reason, Applicants submit that the AAPA and Pinney fails to teach all of the claim limitations of claims 19-22. Withdrawal of the rejection is respectfully requested.

Regarding dependent claim 4, claim 4 is dependent on independent claim 19. Accordingly, Applicants submit that claim 4 is allowable at least for the reasons given above regarding independent claim 19. Withdrawal of the rejection is respectfully submitted.

Notwithstanding the above technical distinctions, and even assuming *arguendo* that the AAPA is combinable with Pinney, which Applicants submit it is not, the Examiner has failed to establish a *prima facie* case of obviousness in combining the AAPA with Pinney, essentially using Applicants' specification as a blueprint to piece together elements.

1. Rejection fails test for establishing prima facie case of obviousness.

Applicants direct the Examiner's attention to two recent cases decided by the Court of Appeals for the Federal Circuit (CAFC), In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed.Cir. 1999) and In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed.Cir. 2000). Both of these cases set forth very rigorous requirements for establishing a prima facie case of obviousness under 35 U.S.C. §103(a). To establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant. The motivation suggestion or teaching may come explicitly from one of the following:

- (a) the statements in the prior art (patents themselves)
- (b) the knowledge of one of ordinary skill art, or in some cases,
- (c) the nature of the problem to be solved.

See Dembiczak 50 USPQ at 1614 (Fed.Cir. 1999). In Kotzab, the CAFC held that even though various elements of the claimed invention were present (in two separate embodiments of the same prior art reference), there was no motivation to combine the elements from the separate embodiments, based on the teachings in the prior art.

In order to establish a prima facie case of obviousness under 35 U.S.C. §103(a), the Examiner must provide particular findings as to why the two pieces of prior art are combinable. See Dembiczak 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence".

In order to provide motivation for combining AAPA with Pinney to reject claim 19, on page 2 of the Office Action of December 18, 2003, the Examiner asserts:

It would have been obvious . . . to have modified the circuit of APA with the current limiter circuit as taught by Pinney in order to limit the bias current, and reduce input power supply to the integrated circuit.

Applicants have reviewed the entirety of Pinney, and do not see how this reference provides a reference that one of ordinary skill in art would look to in order to combine with the AAPA.

FIG. 1 of AAPA illustrates two circuits connected to a circuit element, where a bias current is introduced to a Magneto-resistive Read Head (MR-HEAD) by the circuitry. FIG. 5 of Pinney includes an illustration of a schematic diagram of first stage pre-regulator 204. The pre-regulator is a voltage source that receives a flow of input current, the input current is limited from the ENABLE of signal line 64. See column 6, lines 10-13. By turning off first storage pre-regulator 204 when power signal VCCR (on output line 56 of primary regulator 20) reaches a stable condition, the bias current is limited to first stage pre-regulator 204. The power conserving efforts disclosed in Pinney further include references to battery operated systems and energy conservation goals. See column 9, lines 62-66. Furthermore, Pinney discloses disabling a circuit to prevent over consumption of a bias current for several different electrical circuitry implementations which may reduce power dissipation for an integrated circuit, faster integrated circuitry design considerations, less interference between circuitry elements, and which may lower power consumption for DRAM integrated circuits, for example. See column 3, lines 1-25.

In light of the above disclosure in Pinney, Applicants submit that the Examiner has not identified any teaching or suggestion, anywhere in Pinney, that would lead one skilled in the art to look to Pinney for a third electrical circuit that is connected to both first and second circuits for limiting the value of a bias current to a predetermined level in response to an abnormal current condition of the circuit element, as recited in claim 19.

Accordingly, Applicants respectfully submit that independent claim 19 and those claims dependent thereon are allowable for at least the reason that the Examiner has failed to establish a proper *prima facie* case of obviousness under 35 U.S.C. 103(a), in view of Dembiczak and Kotzab. Independent claims 20-22 contain somewhat similar subject matter as independent claim 19. Accordingly, independent claims 20-22 are allowable for at least those reasons set forth above with regard to independent claim 19.

2. Examiner using Impermissible Hindsight.

The Examiner is using impermissible hindsight reconstruction to reject the claims. The Examiner has used the present application as a blueprint, selected AAPA as the main structural device, and then searched other prior art for the missing elements without identifying or discussing *any specific evidence of motivation to combine*, other than providing conclusory statements regarding the knowledge in the art, motivation and obviousness. The Federal Circuit has noted that the PTO and the courts "cannot use hindsight reconstruction to *pick and choose among isolated disclosures in the prior art to deprecate the claimed invention*," In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988), and that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. Dembiczak, 50 USPQ2d at 1617.

Applicants respectfully submit that claims 19-22 and those claims dependent thereon are allowable for at least this additional reason.

Conclusion

Accordingly, in view of the above amendments and remarks, reconsideration of the objections and rejections and allowance of each of claims 2-4 and 6-22 in connection with the present application is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Matthew J. Lattig, Reg. No. 45,274 at the telephone number of the undersigned below.

In the event this Response does not place the present application in condition for allowance, applicant requests the Examiner to contact the undersigned at (703) 668-8000 to schedule a personal interview.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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By

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